

REMARKS

Summary of the Office Action

Claims 1, 10, and 21 stand objected to because of minor informalities.

Claims 10, 11, 16, 17 and 21 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,584,060 to *Oochida et al.* (hereinafter *Oochida*).

Claims 1, 2, 5-7, 10-11, and 15-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,483,650 to *Imai* in view of *Oohchida*.

Claims 3, 8, 13, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Imai* in view of *Oohchida*, as applied to claims 1, 6, 10, and 16 above, and further in view of U.S. Patent No. 6,637,657 to *Barkan et al.* (hereinafter *Barkan*).

Claims 4, 9, 14, and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Imai* in view of *Oohchida*, as applied to claims 1, 6, 10, and 16 above, and further in view of JP 09-213989 to *Sakakibara et al.* (hereinafter *Sakakibara*).

Claims 12 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Imai* in view of *Oohchida*, as applied to claims 10 above, and further in view of U.S. Patent No. 6,404,709 to *Kouno*.

Claim 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Oohchida*, as is applied to claim 21 above, and further in view of U.S. Patent No. 4,926,036 to *Maeda*.

Summary of the Response to the Office Action

Claims 1, 6, 10, 16, and 21 have been amended to more particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Accordingly, claims 1-19 and 21-23 are presently pending for consideration.

The Claims Do Not Contain Objectionable Matter

Claims 1, 10, and 21 stand objected to because of minor informalities. By way of the foregoing amendment, these minor informalities have been addressed in accordance with the Examiner's suggestions. Accordingly, Applicants respectfully request that the objection to claims 1, 10, and 21 be withdrawn.

All Claims Comply With 35 U.S.C. §102(e)

Claims 10, 11, 16, 17 and 21 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Oochida*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Oochida* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, the Office Action states that *Oochida* discloses a lead frame package (element 121 of Fig. 16) having a sub-mount (a portion of 121). However, the so-called sub-mount is actually a void space as shown in Fig. 16. Therefore, given the geometry of *Oochida*, the light source cannot be mounted on said sub-mount as called for in claims 10, 16, and 21.

Further, Applicants contend that newly amended independent claims 1 and 10 recite the features of "said photo detector is positioned in the second path to optimize the reception of diffracted beams from the hologram optical element," and newly amended independent claims 6, 16, and 21 recite the features of "said photo detector is positioned in the diffraction path such that the photo detector is optimally placed to receive the diffracted beams from the hologram optical element." At least these features are not disclosed or taught by *Oochida*.

The Office Action states that *Oochida* discloses “the detecting unit is located [in] a position to receive beams diffracted from said hologram optical element (Fig. 15), it is inherent that the detecting unit was moved to that position before being fixed to (integrated with) the lead frame package.” See page 5, first paragraph, of the Office Action.

However, *Oochida* discloses all the components are integrated into one chassis to form a cell-structure. That is, *Oochida* discloses that the components are located in fixed positions as determined by the openings manufactured in the chassis. In fact, *Oochida* states that “Fig. 16 illustrates a portion of an optical pick-up device, in which the semiconductor laser light source 11, the birefringent holographic diffraction component 55, the photodetector unit 31, and the prism-like optical member 71 having a reflective surface are housed at respective prescribed positions in the chassis 121.” See col. 22, lines 3-17 of *Oochida*. *Oochida* further states that one of the advantages of the cell-structure is “stabilizing positional errors of respective components.” This is contrary to the present invention.

Therefore, *Oochida* teaches away from the present invention, which improves upon the conventional art by allowing for movement and rotation of the photo detector’s substrate to optimally align the photodetector with the diffracted beams from the hologram optical element. Because *Oochida* does not disclose the above-mentioned optimizing features of independent claims 1, 6, 10, 16, and 21, it cannot anticipate the invention.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the

rejection under 35 U.S.C. § 102(e) should be withdrawn because *Oochida* does not teach or suggest each feature of independent claims 1, 6, 10, 16, and 21.

Additionally, Applicants respectfully submit that dependent claims 2-5, 7-9, 11-15, 17, 19-20 and 22-23 are also allowable insofar as they recite the patentable combinations of features recited in claims 1, 6, 10, 16, and 21, as well as reciting additional features that further distinguish over the applied prior art.

The Office Action also states that features of the present invention are “inherent” because the detecting unit in *Oochida* is moved to its prescribed position within the cell-structure for assembly. See page 5 of the Office Action.

However, M.P.E.P. § 2163.07(a) states that “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).”

Applicants respectfully submit that a photo detector positioned to optimize the reception of diffracted beams from a hologram optical element is not inherent in *Oochida*. The mere movement of the *Oochida* detecting unit to a prescribed position within the cell-structure does not inherently contain the recited features. The Office Action provides absolutely no evidence that the detecting unit in *Oochida* is optimally positioned for reception of diffracted beams. The fact that a detecting unit is placed in a prescribed position of a cell-structure is not sufficient to establish inherency.

All Claims Comply With 35 U.S.C. §103(a)

Claims 1, 2, 5-7, 10-11, and 15-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,483,650 to *Imai* in view of *Oohchida*.

Imai does not overcome the above-mentioned deficiencies of *Oochida*. That is, *Imai* does not teach or suggest the features of newly amended independent claims 1 and 10 that recite “said photo detector is positioned in the second path to optimize the reception of diffracted beams from the hologram optical element,” and newly amended independent claims 6, 16, and 21 that recite the features of “said photo detector is positioned in the diffraction path such that the photo detector is optimally placed to receive the diffracted beams from the hologram optical element.” At least these features are not taught or suggested by *Imai* or *Oochida*. The Office Action has not established a *prima facie* case of obviousness at least because neither *Imai* nor *Oochida*, whether alone or in combination, teach or suggest all the recited features of independent claims 1, 6, 10, and 16.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicant respectfully asserts that the third prong of *prima facie* obviousness has not been met. Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Imai* and *Oochida* do not teach or suggest each and every feature of independent claims 1, 6, 10, and 16.

Additionally, Applicant respectfully submits that dependent claims 2, 5, 7, 11, 15, and 17 are also allowable insofar as they recite the patentable combinations of features recited in claims

1, 6, 10, and 16 as well as reciting additional features that further distinguish over the applied prior art.

Claims 3, 8, 13, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Imai* in view of *Oohchida*, as applied to claims 1, 6, 10, and 16 above, and further in view of *Barkan*. Claims 4, 9, 14, and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Imai* in view of *Oohchida*, as applied to claims 1, 6, 10, and 16 above, and further in view of *Sakakibara*. Claims 12 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Imai* in view of *Oohchida*, as applied to claims 10 above, and further in view of *Kouno*. And, claim 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Oohchida*, as applied to claim 21 above, and further in view of *Maeda*.

To the extent that the Examiner may consider these rejections to still apply, Applicants respectfully assert that the 35 U.S.C. § 103(a) rejections based upon *Imai* in view of *Oohchida* together with either *Barkan*, *Sakakibara*, *Kuono*, or *Maeda* do not cure the deficiencies of *Imai* in view of *Oohchida* as discussed above with regard to independent claims 1, 6, 10, 16 and 21, as amended. Further, Applicants respectfully assert that claims 2-5, 7-9, 12-15, 17-19, and 22-23 are allowable at least because of their dependence on their respective independent claims, as amended, and for the additional features that they recite. Accordingly, Applicants respectfully request that the 35 U.S.C. § 103(a) rejections of claims 1-19 and 21-23 be withdrawn.

CONCLUSION

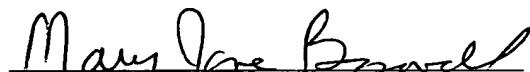
In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,
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